

Remarks

No claims have been amended. Claims 17, 23, 24, 33, and 34 have been canceled. Claims 15, 16, 18, 25-32 remain pending in the application.

Inventor Name Change

After this patent application was filed, the inventor became a US citizen and formally changed his name. A separate petition is being filed concurrently herewith requesting that the USPTO records be altered based on the inventor's name change. All future correspondence regarding this application should reflect the inventor's new name of Cyrus Kurosh Samari.

35 U.S.C. §112

The Examiner rejected claim 34 under 35 U.S.C. 112, second paragraph as failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention. In addition, claims 17, 23, 24, 33, and 34 were rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement. The Applicant notes that claims with similar wording have been pending in this application for several years and in fact the use of the term "section" was even suggested by the Examiner. As such, it is somewhat curious that this issue with the language of the claims involving "a section" is being raised for the very first time in a Final Office Action rather than a Non-Final Office Action. While the Applicant may not agree with the assertions made by the Examiner regarding the language of the claims, in an effort to reduce examination issues in the pending application, claims 17, 23, 24, 33, and 34 have been canceled. Applicant respectfully submits that the objections to the claims under both the first and second paragraph of 35 U.S.C. 112 are no longer relevant to the presently pending patent application and requests that they be withdrawn.

Applicant expressly reserves the right to pursue these claims or others directed to similar subject matter in a continuation application. A continuation application has been filed with the USPTO as U.S. Patent Application No. 12/212,523 on September 17, 2008 which contain claims similar to those now canceled.

35 U.S.C. §103

Claims 15, 16, 18 and 25-32 were rejected under 35 USC 103(a) as being unpatentable over Pelanek, U.S. Patent No. 5,724,682 (Pelanek) and in view of Murray et al., U.S. Patent No. 5,721,891 (Murray) and further in view of Koritzinsky, U.S. Patent No. 6,988,074 (Koritzinsky) and further in view of Kahle, U.S. Patent No. 5,518,325 (Kahle) and further in view of Laney et al., U.S. Patent No. 6,366,966 (Laney) (collectively referred to as the "Cited References").

Applicant respectfully suggests that the Examiner has failed to establish a *prima facie* case of obviousness. On careful review of this rejection as found pages 4 through 6 of the most recent office action, it appears to be substantially similar to one previously presented by the Examiner and refers to features and claim language not presently in the pending claims. More over, these comments from the Examiner seem to skip over or omit mentioning several elements of the presently pending claims. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a).

To establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. More specifically, the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. If the examiner fails to establish a *prima facie* case, the rejection is improper and must be withdrawn.

In this case, the Examiner has asserted in the Final Office Action that all of the elements of claims 15, 16, 18 and 25-32 are taught by a combination of five different references. In an attempt to establish this assertion at pages 4-6 of the Final Office Action, the

Examiner randomly describes features of the Pelanek reference. Rather than identifying specific elements or language of the presently pending independent claim 15 or any other dependent claim, the Examiner has chosen to put forth this description of the Pelanek reference alone and in various combinations with the other Cited References. Not one of these passages from Pelanek is ever identified as teaching a specific feature described in claim 15. Such random citation of passages simply does not meet the Examiner's burden to present evidence and create a written record as required by the Courts and the USPTO. Further, such conclusory statements on prior art combinations are not permitted, the Examiner must set forth the rational upon which he relies. In Graham v. John Deere, the Supreme Court identified four factual inquiries that need to be done to determine obviousness under 35 U.S.C. §103(a). These inquiries are:

- (a) determining the scope and contents of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating evidence of secondary considerations.

Graham v. John Deere, 383 U.S. 1, 148 USPQ 459 (1966). More particularly, the Final Office Action fails to establish the scope and content of the prior art. Thus, the Applicant has not been provided a *prima facie* case of obviousness which it could rebut and all four factual inquiries could not be completed. As such, this obviousness rejection is flawed and must be withdrawn.

The Applicant respectfully requests the production of an evidentiary record for the Office Notice taken by the Examiner. As the Examiner well knows, the factual question of motivation to combine is material to patentability, and can not be resolved on subjective belief and unknown authority. The finding of obviousness must be based upon substantial evidence, and not subjective musings or conjecture by the Examiner. Deficiencies in the evidentiary record cannot be cured by general conclusions such as "general knowledge" or "common sense." Accordingly, the Examiner cannot rely on unsupported, conclusory statements to close holes in the evidentiary record. Unless the

Examiner can establish an evidentiary record based on concrete prior art references that establish that it would have been obvious to a person with ordinary skill in the art to incorporate the features of Applicant's dependent claims, the claims should be allowed.

In the present patent application, the Examiner has not provided substantial evidence regarding at least the features of the present invention as claimed in dependent claims 27 and 28. Therefore, the Applicant respectfully requests that such evidence be provided or this unsubstantiated objection to the claims be withdrawn.

After reviewing Pelanek and the other Cited References for their potential teachings, the Applicant finds some teaching of medical data recording methods. However, when carefully reviewing these Cited References, several features of the presently pending independent claim 15 do not appear to be taught or even contemplated by Pelanek. \

In particular, neither Pelanek nor any of the other Cited References teach or suggest parsing patient identification information and study information from received medical data and later labeling a disc with that parsed information as now claimed in independent claim 15. The instant invention as claimed in independent claim 15 describes receiving medical data and parsing that data with a software module for patient identification information and study information. Subsequently, a disc is recorded with the received medical data and a template is printed with the parsed patient information and study information to label the disc itself. The specification at page 6, line 9 to page 10, line 4 describes a preferred embodiment process where the data is automatically extracted by parsing the received data and later the parsed data is used in printing on a disc to label the disc. This process is simply not taught by Pelanek alone or in combination with any of the other cited references. Pelanek does not teach or suggest printing a label on a disc. The Examiner cites Kahle as teaching a print template file and merge file used to print on a disc, neither Pelanek nor Kahle teach that the source of the data printed on the disc includes parsed patient identification information and parsed study information. The parsed patient identification information and parsed study information as claimed comes from the medical data received by the software module and not some user input through a user input device 44 as suggested by Pelanek at column 5, line 40. Thus, none of the Cited References teach or suggest

parsing received medical data with a software module for patient identification information and study information and subsequently printing a template with that parsed information to label the disc.

Another feature that Pelanek and the other Cited References fail to teach or suggest as now claimed in independent claim 15 is to record medical data viewing software on the same disc as the medical data. By not even mentioning this feature, the Examiner seems to implicitly acknowledge that Pelanek does not teach or describe this feature as claimed in independent claim 15. The Examiner mentions Laney as teaching recording software on the medium for viewing the data stored thereon. This is a rather curious comment about Laney, because Laney is directed to a Microsoft Windows operating system feature for automatically running a CD when it is inserted into a computer. Neither in the column and lines in Laney identified by the Examiner nor anywhere else in the Laney reference is it suggested or taught that it is desirable to record medical data viewing software as well as medical data on the same disc. In addition, none of the other Cited References describe this feature as claimed. Thus, none of the Cited References teach or suggest recording a disc with the data produced by the job where the job contains medical data and medical data viewing software.

Overall the assertion of obviousness made in the Final Office Action with respect to the dependent claims as based on five references from disparate and non-analogous technical arts appears to take into account more knowledge than what was within the level of ordinary skill in the art at the time the claimed invention was made, and appears to include additional knowledge gleaned only from the Applicant's disclosure (i.e., improper use of hindsight). The Applicant respectfully points out that the reference must, at a minimum, either be in the field of Applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. It does not appear as if that is the case with many of the Cited References. Further, the gaps in the teachings between these Cited References simply can not be bridged by common sense alone. The gist of the present invention as claimed lies within these gaps, including but not limited to, the unique combination of features of a method for

recording medical data on a disc. As such, this obviousness rejection is flawed and must be withdrawn.

Claims 16, 18 and 25-32 depend from claim 15 and therefore are allowable over the Cited References for the same reasons that claim 15 is allowable.

In summary, the Cited References fail to teach at least the two features described in pending independent claim 15. These two features are: (1) parsing received medical data with a software module for patient identification information and study information and subsequently printing a template with that parsed information to label the disc; and (2) recording a disc with the data produced by the job where the job contains medical data and medical data viewing software. Therefore, under 35 USC 103(a), the Cited References, namely over Pelanek, Murray, Koritzinsky, Kahle, and Laney fail to teach the present invention as claimed in claims 15, 16, 18, 25-32 and withdrawal of this rejection is respectfully requested.

Conclusion

On the basis of the foregoing, Applicant respectfully submits that claims 15, 16, 18, 25-32 are now believed to be in condition for allowance. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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